

REMARKS

This is in response to the final Office Action mailed on June 11, 2009, and Advisory Action mailed on August 12, 2009 for the above-referenced application. Claims 1-38 have been cancelled and new Claims 39-53 have been added. Support for the new claims can be found throughout the specification, and particularly at paragraph [1026] of the specification. Applicant thanks the Examiner for his review of the application and respectfully request reconsideration of the pending claims in view of the remarks and new claims contained herein.

Terminal Disclaimer

The Examiner stated that a terminal disclaimer was required in view of U.S. Patent No. 6,292,662. However, in light of the cancellation of Claims 1-38 and introduction of new Claims 39-55, Applicant respectfully requests that the Examiner revisit the double patenting rejection. Applicant believes that no terminal disclaimer is necessary in view of newly-introduced claims. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Discussion of Rejection under 35 USC § 103

The Examiner has now rejected Claims 28-38 as unpatentable over five references, namely Kotzin in view of Roach and (Widmark or Munk) and Baran (U.S. Patent 4,771,425). Applicant respectfully disagrees that the pending claims are obvious in view of all these references for the reasons discussed below.

In order for the Examiner to make a *prima facie* case of obviousness, each and every limitation of the claim must be found, directly or inherently, in the cited art. However, as discussed below, the Examiner has not found each and every element of the claims in the prior art. Thus, the Examiner has failed to make his *prima facie* case.

New Claims 39-55 relate to methods, apparatuses and storages for processing a telephone call from a first subscriber unit to a second subscriber unit. Claims 39 and 55 recite “determining if the second subscriber unit incorporates vocoding techniques that are compatible with the first subscriber unit” and “routing vocoded data packets from the first

subscriber unit to the second subscriber unit without devocoding if the first and second subscriber units have compatible vocoding techniques". Claim 46 recites "a call control processor configured to receive information indicating whether the second subscriber unit incorporates vocoding techniques that are compatible with the first subscriber unit" and "a service options element configured to receive a binary copy of vocoded data packets from the second subscriber unit and transmit the binary copy of the vocoder data packets to the first subscriber unit when the second subscriber unit incorporates compatible vocoding techniques." Claim 49 recites "means for determining if the second subscriber unit incorporates vocoding techniques that are compatible with the first subscriber unit" and "means for routing vocoded data packets from the first subscriber unit to the second subscriber unit without devocoding if the first and second subscriber units have compatible vocoding techniques".

None of Kotzin, Roach, Widmark or Munk describe a system, individually, or together, that include determining whether a first subscriber and a second subscriber use compatible vocoder techniques. Nor do any of these references, alone or in combination, teach transmitting vocoder data packets from a first subscriber to a second subscriber if a determination is made that the first and second subscriber units incorporate compatible vocoding techniques. As discussed throughout the specification, the claimed system and methods are advantageous because they do not need to double vocode data once a determination is made that the first subscriber unit and the second subscriber unit send compatible vocoder data packets.

Accordingly, the combination of Kotzin in view of Roach and (Widmark or Munk) and Baran do not teach each and every element of the claims. For this reason, Applicant respectfully requests withdrawal of this rejection.

CONCLUSION

In view of the foregoing, Applicant submits that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

Dated: 6 Sept 2009

By: A. Mauro II
Anthony P. Mauro II
Reg. No. 63,702
Tel. No. 858-658-5698

QUALCOMM Incorporated
Attention: Patent Department
5775 Morehouse Drive
San Diego, California 92121
Telephone: (858) 658-5698
Facsimile: (858) 658-2502